Supreme Court, U. S.
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IN THE

# Supreme Court of the United States

October Term, 1979
No. 79-812

OSMOSE WOOD PRESERVING CO., OF AMERICA, INC., *et al.*,
*Petitioners,*

*vs.*

CITY OF LOS ANGELES, California, a municipal corporation,
*Respondents.*

**Opposition to Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.**

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February 1980

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I.

## Statement of the Case.

The patent involved in this litigation is directed to a method to prevent marine borers from attacking submerged wooden pilings by wrapping same in plastic, much the same as a sandwich may be wrapped to protect same from insects. The subject matter could not be simpler or more obvious. During discovery, the Patentee refused repeatedly to advise whether any result was obtained from the steps set forth in the claims which could be tested under the various controlling decisions of this Court. The patentee's refusal to make such discovery resulted in the trial court's holding upon summary judgment that the patent was invalid under 35 U.S.C. §103 as failing to meet the standards set forth

in *Graham v. John Deere Co.*, 383 U.S. 1; *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corporation*, 340 U.S. 147 and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273.

II.

**Argument.**

Upon appeal, the Ninth Circuit affirmed after carefully pointing out each of the steps claimed in the method were old and the items urged by the Patentee upon appeal as new, were in fact not new. As of this date the Patentee has not identified any theory upon which his specific process of wrapping plastic around a submerged piling differs patentably from the various methods by which the identical result was obtained by the prior art.

Accordingly, in order the Appellate Court determined that the patent in suit did not meet the standards of patentability under *Graham v. John Deere Co.*, 383 U.S. 1; *Great Atlantic and Pacific Tea Co. v. Supermarket Corporation*, 340 U.S. 147, or *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273.

The Appellate Court made no effort to suggest that there was any difference or conflict between these three decisions or in any way indicated its decision conflicts with the Seventh Circuit in *A.M.P. Inc. v. Bunker Ramo Corp.*, referred to in the Petition For Writ of Certiorari which decision was not cited or mentioned in the proceedings before the Appellate Court.

Thus it seems clear that the Ninth Circuit in this case in effect applied the same criteria as the Seventh Circuit in reaching its conclusion. If any intention to repudiate or conflict with same, the court should have had this argument presented to it and be given an opportunity to so state as apparently the Second and Tenth Circuits have in *Champion Spark Plug Co. v. Gyromat Corp.*, 202 U.S.P.Q. 785 and



*Plastic Container Corp. v. Continental Plastics of Oklahoma*, 203 U.S.P.Q. 27 referred to on page 8 of the Petition.

Thus, this action does not present any conflict between the Circuits as the Ninth Circuit applied the *Graham* test and found the patent invalid. Although it went on to point out that the patent failed to meet also the language in *A&P* as well as *Sakraida*, this does not present a direct conflict between the Circuits and this Court can dispose of the case without having to resolve any asserted conflict.

**Conclusion.**

Assuming for the sake of argument that a conflict exists between the Seventh Circuit on the one hand, and the Second and Tenth Circuits upon the other, this case is not the proper vehicle for determination of same. The Ninth Circuit did not have such asserted conflict urged before it nor an opportunity to pass upon the questions. If the Court does determine that it should again review the test for patentable invention, this case is not the proper vehicle, as it can and should be disposed of before any such determination is reached.

Dated: February 1980.

Respectfully submitted,

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